

## **REMARKS**

Reconsideration of this application is respectfully requested.

### **A. Claim Amendments**

The listing of claims presented herein cancels claims 4 and 14-17, and amends claims 1, 2, 11, 18-20, 26-28, and 30-32. With entry of this amendment, claims 1, 2, 6, 7, 9-13, 18-20, 22-24, and 26-33 are pending in the application.

This amendment is made without prejudice to or disclaimer of subject matter cancelled from the claims.

The amendments to the claims find support in the application as filed, as indicated in the following table.

<b>Claim</b>	<b>Support</b>
1	Page 1, lines 7-11; page 6, lines 6-10; page 7, lines 4-5 and lines 31-34.
2	Page 7, lines 31-34
11	Page 1, lines 21-29.
18	Page 8, lines 10-21.
19	Page 1, lines 7-11; page 7, lines 31-34.
20	Page 6, lines 30-34.
26	Page 1, lines 7-11; page 7, lines 31-34.
27	Page 1, lines 7-11; page 6, lines 6-10; page 7, lines 4-5 and lines 31-34.
28	Page 1, lines 7-11; page 6, lines 6-10; page 7, lines 4-5.
30	Page 1, lines 7-11; page 7, lines 31-34.
31	Page 6, lines 30-34.
32	Page 1, lines 7-11.

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As the claims do not add new matter, applicants submit that entry of this amendment is proper.

B. Claim Objections

The Examiner objected to claims 1, 19, 26-28, 30, and 32, requesting that "heat-sealed jaws" be changed to "heat-sealing jaws." Applicant thanks the Examiner for the suggestion and has made this change. Accordingly, applicant requests that this objection be withdrawn.

C. Claim Rejections Under 35 U.S.C. § 112

The Office rejected claims 1, 2, 4, 6, 7, 9-20, 22-24, and 26-33 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action at item 3.) Applicant respectfully traverses the rejection.

Regarding claim 1, the Office contends that there is no structural/functional relationship between the sensor and the means suitable to reposition the film. (Office Action at item 3.) Regarding claim 19, the Office contends that there is no structural/functional relationship between the detecting and the repositioning. (Office Action at item 3.) Regarding claim 26, the Office contends that there is no structural/functional relationship between the sensor and the means suitable to reposition the film. (Office Action at item 3.) Finally, the Office contends that each of claims 27, 28, 30, and 32, lack any structural/functional relationship between the sensor(s) and the heat-sealed jaws. (Office Action at item 3.)

Amended claim 1 recites “wherein said repositioning means is responsive to detection of a default position by the sensor.” Applicant submits that this language reveals a structural/functional relationship between the sensor and the means suitable to reposition the film.

Amended claim 19 recites “wherein the repositioning is by a repositioning means responsive to detection of a default in the position of the tape by the sensor.” Applicant submits that this language reveals a structural/functional relationship between the detecting (by the sensor) and the repositioning (by the repositioning means).

Amended claim 26 recites “wherein said repositioning means is responsive to said default signal.” The default signal comes from the sensor. Applicant submits that this language reveals a structural/functional relationship between the sensor (which sends the default signal) and the means suitable to reposition the film.

Amended claims 27, 28, 30, and 32 recite “wherein said heat-sealing jaws are responsive to detection by the sensor.” Applicant submits that this language reveals a structural/functional relationship between the sensor and the heat-sealed jaws.

A structural/functional relationship now exists between the sensor and the repositioning means or heat-sealed jaws in claims 1, 19, and 26-28, 30, and 32, as amended. Applicant submits that amended claims 1, 19, 26-28, 30, and 32 are not indefinite. Accordingly, applicant respectfully request that the rejection be withdrawn.

The rejection of claim 4 has been rendered moot by the cancellation of the claim.

The Office alleged that claim 11 is indefinite, asserting that “it is unclear what other type of □ closure tape □ comprises the group of closure tape.” Applicant submits

that the amendment of claim 11 has rendered any alleged indefiniteness of the claim moot. Accordingly, applicant respectfully requests that this rejection be withdrawn.

D. Claim Rejections Under 35 U.S.C. § 102

The Office rejected claims 1, 2, 6, 7, 10, 11, 13, 14, 16, 19, 20, and 27 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,876,842 to Ausnit ("Ausnit"). Applicant respectfully traverses the rejection and respectfully requests reconsideration of the rejected claims.

A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. M.P.E.P. 2131, *quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicant's claims recite an apparatus comprising at least one sensor "wherein the sensor comprises dual feelers that are juxtaposed in the longitudinal direction of the film." In applicant's claimed apparatus, each of the dual feelers detects the presence of a tape at a position on a traveling film. Thus, Ausnit can anticipate applicant's claims if and only if Ausnit discloses an apparatus comprising at least one sensor wherein the sensor comprises dual feelers juxtaposed in the longitudinal direction of the film.

Ausnit discloses a method and apparatus for packaging product masses in a form, fill and seal machine using a longitudinal fastener strip. The apparatus of Ausnit comprises dual sensors (25) provided to detect, respectively, a film index spot means (27) and an index spot means provided on the fastener assembly (17). (See Ausnit at col. 3, lines 27-39.) Because the fastener strip is provided in the longitudinal direction, the sensor provided to detect the film index spot means (27) must be juxtaposed

transversely to the sensor provided to detect the index spot means provided on the fastener assembly (17); otherwise, both sensors (25) of Ausnit would detect the index spot means provided on the fastener assembly (17) and no sensor would detect film index spot means (27). The transverse juxtaposition of the dual sensor of Ausnit is clearly reflected in the apparatus depicted in Figure 1 of Ausnit, for example.

If the dual sensors of Ausnit are viewed as equivalent to the sensor recited in applicant's claims, then Ausnit fails to disclose all elements of applicant's claims, because the dual sensors of Ausnit clearly do not comprise dual feelers juxtaposed in the longitudinal direction of the film, as recited in applicant's claims. If, on the other hand, the sensors of Ausnit are viewed as equivalent to the dual feelers of applicant's claims, then Ausnit likewise fails to disclose all elements of applicant's claims, because the dual sensors of Ausnit are not juxtaposed in the longitudinal direction of the film, as are the dual feelers of applicant's claims. Either way, Ausnit does not disclose each and every element as set forth in applicant's claims and, therefore, can not anticipate applicant's claims.

Applicant has shown that Ausnit does not anticipate applicant's claims and respectfully requests that the rejection of claims 1, 2, 6, 7, 10, 11, 13, 14, 16, 19, 20, and 27 under 35 U.S.C. § 102(b), as anticipated by Ausnit, be withdrawn.

The Office also rejected claims 1, 6, 9-14, 19, and 20 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,745,731 to Talbott ("Talbott"). Applicant respectfully traverses the rejection and respectfully requests reconsideration of the rejected claims.

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Talbott discloses an apparatus comprising two sensors (21). Each sensor detects one of two opposite edges of a film to control the positioning of an unwound web so that the edges of the web are precisely positioned with respect to a filling assembly (13). Because the aim of the two sensors (21) is to detect, respectfully, the two edges of the film, the two sensors (21) may not be longitudinally juxtaposed (otherwise they would both detect the same edge). Consequently, the two sensors (21) as disclosed in Talbott must be juxtaposed transversely to the travel direction of the film. The transverse juxtaposition of the two sensors of Talbott's apparatus is clearly reflected in the apparatus depicted in Figure 1 of Talbott, for example.

If the two sensors of Talbott are viewed as equivalent to the sensor recited in applicant's claims, then Talbott fails to disclose all elements of applicant's claims, because the two sensors of Talbott clearly do not comprise dual feelers juxtaposed in the longitudinal direction of the film, as recited in applicant's claims. If, on the other hand, the sensors of Talbott are viewed as equivalent to the dual feelers of applicant's claims, then Talbott likewise fails to disclose all elements of applicant's claims, because the dual sensors of Talbott are not juxtaposed in the longitudinal direction of the film, as are the dual feelers of applicant's claims. Either way, Talbott does not disclose each and every element as set forth in applicant's claims and, therefore, can not anticipate applicant's claims.

Applicant has shown that Talbott does not anticipate applicant's claims and respectfully requests that the rejection of claims 1, 6, 9-14, 19, and 20 under 35 U.S.C. § 102(b), as anticipated by Talbott, be withdrawn.

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E. Claim Rejections Under 35 U.S.C. § 103(a)

The Office rejected claims 4, 15, 17, 18, and 22-24 under 35 U.S.C. § 103(a), as allegedly obvious over Ausnit or over Talbott. It is the Office's position that the location of the sensor with respect to the travel direction of the film strips is obvious to one of skill in the art as a matter of engineering choice, because, the Office contends, the location of the sensor does not solve any stated problem insofar as the record is concerned, and thus does not patentably distinguish the claimed invention over the cited art. (Office Action at item 8.) Applicant respectfully traverses the rejection and respectfully requests reconsideration of the rejected claims.

The Office supports its contention, that the location of the sensor with respect to the travel direction of the film strips is obvious to one of skill as a matter of engineering choice, by citing *Ex parte Masham*, 2 U.S.P.Q.2d 1647 (Bd. Pat. App. & Interf. 1987). In *Ex parte Masham*, the Board held that "a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed," and that "a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed." *Ex parte Masham* at 1648. In contrast to the claim at issue in *Ex parte Masham*, applicant's amended claims recite a structural limitation—"the sensor comprises dual feelers that are juxtaposed in the longitudinal direction of the film"—that is not disclosed anywhere in Ausnit or Talbott.

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Applicant respectfully submits that *Ex parte Masham*'s prohibition on reading recitations regarding the material intended to be worked upon by a claimed apparatus, or the manner in which a claimed apparatus is intended to be employed, into the structural limitations of an apparatus claim, does not provide justification for the Office to read applicant's claimed structural limitations out of applicant's claims. *Ex parte Masham* does not support the contention that applicant's claims are obvious.

Further, when the Office characterizes applicant's claimed structural limitations as mere engineering choices, and thus not patentably distinguished from the apparatus of Ausnit and Talbott, the Office is impermissibly modifying Ausnit and Talbott to change the principle or operation of the apparatus disclosed in the references. (See M.P.E.P. 2143.01, *citing In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959) ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the [reference or] references are not sufficient to render the claims *prime facie* obvious.").)

Specifically, as described above, if both sensors (25) of Ausnit were oriented longitudinally to the direction of travel of the film, they would both detect the index spot means provided on the fastener assembly (17) and no sensor would detect the film index spot means (27), which Ausnit teaches as desirable to assure proper orientation. (Ausnit at col. 3, lines 23-25.) Similarly, Talbott's apparatus comprises two sensors (21), each detecting one of two opposite edges of a film, to control the positioning of an unwound web so that the edges of the web are precisely positioned with respect to a filling assembly (13). To achieve this purpose the two sensors of Talbott must be positioned transversely, not longitudinally.

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Because the apparatus of Ausnit and Talbott would no longer operate as disclosed if modified to meet the limitations of applicant's claims, modification of the references to reach applicant's claims is not obvious as a mere engineering choice, as the Office contends. Thus, neither Ausnit nor Talbott can render applicant's claims obvious.

Applicant has shown that neither Ausnit nor Talbott renders the amended claims obvious and respectfully requests that the rejection of claims 4, 15, 17, 18, and 22-24 under 35 U.S.C. § 103(a), as allegedly obvious over Ausnit or over Talbott, be withdrawn and not applied to the amended claims.

The Office also rejected claim 26 under 35 U.S.C. § 103(a), as allegedly obvious over Ausnit in view of Patent abstract of Japan 11165362 ("PAJ"). (Office Action at item 9.) Applicant respectfully traverses the rejection and respectfully requests reconsideration of claim 26.

As amended, claim 26 recites an apparatus comprising at least one sensor "wherein the sensor comprises dual feelers that are juxtaposed in the longitudinal direction of the film." As described above, Talbott neither discloses nor suggests an apparatus with a sensor comprising dual feelers juxtaposed in the longitudinal direction of the film. Likewise, neither does PAJ. Further, Talbott and PAJ in combination neither disclose or suggest such an apparatus. Thus, Talbott and PAJ do not render claim 26 obvious. Accordingly, applicant respectfully requests that the rejection of claim 26 under 35 U.S.C. § 103(a), as obvious over Talbott in view of PAJ, be withdrawn.

Finally, the Office rejection claims 28-33 under 35 U.S.C. § 103(a), as allegedly obvious over Ausnit in view of Talbott. (Office Action at item 10.) The Office concedes

that Ausnit does not disclose dual mechanical feelers that are juxtaposed in the longitudinal direction of the film. However, the Office contends that Talbott remedies this defect of Ausnit, by disclosing dual sensors (21). Applicant respectfully traverses the rejection and respectfully requests reconsideration of claims 28-33.

The Office does not refer to the dual sensors of Talbott as being juxtaposed in the longitudinal direction of the film. The reason is that the dual sensors of Talbott are not juxtaposed in the longitudinal direction of the film. For example, col. 3, lines 50-64 of Talbott, to which the Office cites, does not make any mention of dual sensors juxtaposed in the longitudinal direction of the film. Further, for example, Figure 1 of Talbott shows dual sensors (21), but the dual sensors are not juxtaposed in the longitudinal direction of the film. Indeed, nothing in Ausnit or Talbott suggests dual sensors juxtaposed in the longitudinal direction of the film. Accordingly, Ausnit and Talbott do not teach or suggest every limitation in the rejected claims. For this reason, Ausnit and Talbott can not render claims 28-33 obvious. See M.P.E.P. 2142.

Applicant has shown that Ausnit in view of Talbott does not render claims 28-33 obvious and respectfully requests that the rejection of claims 28-33 under 35 U.S.C. § 103(a), as allegedly obvious over Ausnit in view of Talbott, be withdrawn.

F. Conclusion

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 2, 6, 7, 9-13, 18-20, 22-24, and 26-33 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 2, 11, 18-20, 26-28, and 30-32 do not raise new issues or necessitate the undertaking

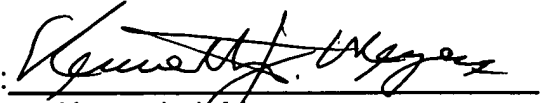
of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 27, 2004

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